

## **REMARKS**

Favorable reconsideration of this application in view of the amendments and remarks to follow and allowance of the claims of the present application are respectfully requested.

Applicants thankfully acknowledge the Examiner's statement that Claims 2-3 and 6-8 would be allowable if rewritten to overcome the rejection under 35 U.S.C. §112, second paragraph, set forth in this Office Action, and include all the limitations of the base claim and any intervening claims. Applicants further thankfully acknowledge the Examiner's statement that Claim 5 would be allowable if rewritten or amended to overcome the rejection under 35 U.S.C. §112, second paragraph, set forth in this Office Action.

In response, applicants have amended the claims as follows. Applicants have deleted Claims 1 and 4 and rewritten Claims 2 and 3 to include all of the limitations of the base claim, i.e., Claim 1. Applicants have also added three new claims, namely, Claims 18-20. Among the new claims, Claims 18 and 19 are dependent on Claims 2 and 3, respectively, and Claim 20 is an independent claim that includes all the limitations of Claims 2 and 3. Further, applicants have amended Claim 5 to include proper Markush-type claim language by replacing the terms "in particular" with "selected from the group consisting of". Support for this amendment can be found at lines 19-21, page 7 of the specification. In addition, applicants have cancelled Claims 9-17 as non-elected subject matter. Since the above amendments to the claims do not introduce any new matter into the application, entry thereof is respectfully requested.

Claims 1-8 stand rejected under 35 U.S.C. §112, second paragraph, as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More specifically, the Examiner alleges that the use of the

terms “a polyhydroxyorganyl radical” and “in particular a glycerol, … or amphoglycinate radical” in Claims 1 and 5 constitutes a narrow range that falls within a broader range in the same claim, thereby renders the claims indefinite. In addition, the Examiner asserts that the method of Claim 5 is confusing because it is not clear how to prepare an organopolysiloxane wherein R4 is a glycerol, polyglycerol, etc.

In response, applicants have amended Claim 5 to include proper Markush-type claim language by replacing the terms “in particular” with “selected from the group consisting of”. Applicants respectfully submit that Claims 2 and 3, as amended, obviate the objection based on under 35 U.S.C. §112, second paragraph.

Further, applicants respectfully submit that Claim 5 conveys to one skilled in the art the meaning of the claimed method with sufficient clarity. The plain language of Claim 5 recites a process for preparing a compound of general formula (I) which comprises adding on polyester radicals either by hydrosilylation of a polyester carrying a double bond to a polyhydrogensiloxane, or by esterification of an OH-functional polysiloxane with a polyester carrying a free carboxyl group. It is well known to one skilled in the art that glycerol, polyglycerol, and other polyhydroxyorganyl recited in Claim 5 are molecules having multiple – OH functional groups. Thus, it is submitted that one skilled in the art would readily ascertain the metes and bounds of Claim 5 upon reading the plain language of the claim.

The rejections under 35 U.S.C. §112, second paragraph, have been obviated; therefore reconsideration and withdrawal thereof is respectfully requested

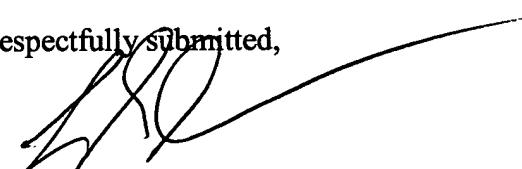
Claims 1 and 4 stand rejected under 35 U.S.C. §102(b) as allegedly anticipated by U.S. Patent No. 5,385,730 to Ichinohe, et al. (hereinafter “Ichinohe, et al.”).

In order to expedite prosecution of the present application and without conceding to the merits of the above rejection, applicants have deleted Claims 1 and 4.

The rejection under 35 U.S.C. §102(b) has been obviated; therefore reconsideration and withdrawal thereof is respectfully requested.

Thus, in view of the foregoing amendments and remark, it is firmly believed that the present case is in condition for allowance, which action is earnestly solicited.

Respectfully submitted,

  
Leslie S. Szivos, Ph.D.  
Registration No. 39,394

Scully, Scott, Murphy & Presser  
400 Garden City Plaza, Suite 300  
Garden City, New York 11530  
(516) 742-4343

LSS/YL:dg